

REMARKS

Claims 1 through 6 are pending in this application. Claims 1 and 6 have been amended and claims 7 and 8 cancelled. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support of for the present Amendment should be apparent from page 9 of the written description of specification, lines 5 through 7, examples 3 and 4 and page 10 of the written description of the specification, lines 7 through 10. Applicant submits that the present Amendment does not generate any new matter issue.

Claim 1 (presumably intending claims 1 through 8) were rejected under the first paragraph of the 35 U.S.C. §112 for adequate descriptive support.

In the statement of the rejection, the Examiner asserted there was no descriptive support in the originally filed disclosure for the recited average chromatic dispersion. This rejection is traversed.

Claim 1 has been amended for clarity by, inter alia, deleting the language the Examiner placed into issue. Moreover, claims 1 and 6 have been amended to specify that the dispersion compensating optical fiber has a length sufficient to compensate the chromatic dispersion at the 1550 nm wavelength, thereby restricting loss. Adequate descriptive support for the present Amendment, as previously pointed out, should be apparent from page 9, lines 5 through 7 wherein it is disclosed that the dispersion compensating optical fiber has as a length sufficient to compensate the chromatic dispersion at the 1550 nm wavelength. Applicant further notes that in examples 3 and 4, the length of the optical transmission fiber is 80km. The loss of the module is 2.8dB. Accordingly, loss

of the module is 0.035dB per unit kilometer of the optical transmission fiber. Applicant would refer to page 10 of the written description of the specification, lines 7 through 10.

Based upon the foregoing, it should be apparent that one having ordinary skill in the art would have recognized from the originally filed disclosure that Applicant invented the now claimed subject matter. *Union Oil Co. of California v. Atlantic Richfield Co.* ___ F.3d ___, 54 USPQ2d (Fed. Cir. 2000).

Applicant, therefore, submits that the imposed rejection of claim 1 (and presumably claims 2 through 6) under the first paragraph of 35 U.S.C. §112 for lack of adequate descriptive support is not viable and, hence, solicits withdrawal thereof.

Claim 6 was rejected under 35 U.S.C. §103 for obviousness predicated upon Judy et al. in view of Sillard et al.

In the statement of the rejection, the Examiner concluded that one having ordinary skill in the art would have found the claimed invention obvious based upon the combined disclosures of Judy et al. and Sillard et al. This rejection is traversed.

There are significant structural differences between the claimed invention and the applied prior art that undermine the obviousness conclusion under 35 U.S.C. §103. Specifically, independent claim 6 is directed to an optical transmission system comprising, inter alia, a module made of a dispersion compensating optical fiber having a particular chromatic dispersion. Moreover, the dispersion compensating optical fiber has a length sufficient to substantially compensate the chromatic dispersion at 1550nm wavelength, and limit the loss of the module at 1550nm wavelength to not more than 0.035db per unit kilometer of said optical transmission fiber. This feature is neither disclosed nor suggested

by the applied prior art. Accordingly, even if the applied references are combined as proposed by the Examiner, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).


Applicant, therefore, submits that the imposed rejection of claim 6 under 35 U.S.C. §103 for obviousness predicted upon Judy et al. in view of Sillard et al. is not factually or legally viable and, hence, solicits withdrawal thereof.

Based upon the foregoing, it should be apparent that the imposed rejections have been overcome and that all claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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